

REMARKS

Reconsideration is requested.

Record of Interview

On June 9, 2004, a telephone interview was conducted between Examiner Eduardo C. Robert and the undersigned, Raymond W. Green. The courtesy of the interview, and the Examiner's preparation for the interview, are noted with appreciation. Prior to the interview, on June 7, I called Examiner Robert and asked if there was any amendment that might be considered to place the Application in condition for allowance. Between June 7 and 9, Examiner Robert reviewed the application in order to answer the question. During the interview, Examiner Robert stated that an amendment to further define the contents of the trays recited in the claims might receive favorable consideration, but that he did not see the basis in the specification for such an amendment.

Discussion of Amendment

Claims 20 and 21 recite lists of vertebroplasty injection components at length. Accordingly, the above new Claims 22 and 23 recite the same vertebroplasty injection components, to further describe the vertebroplasty injection components recited in Claim 17. The amendment to the title is a housekeeping amendment, because while the specification discloses both a method and an apparatus, only apparatus is currently claimed.

Claims 1-21 are retained as previously presented. Claims now presented are Claims 1-23.

Argument

In the non-final Office Action of March 24, 2004, in response to Applicant's Appeal Brief, the Examiner has reopened prosecution, withdrawn two references (Patrika and Folkman), added one new reference (Vagley U.S. Patent 6,158,437), maintained one rejection, withdrawn one rejection, modified one rejection, added one new rejection, and invited either a reply under 37 CFR 1.111 to the non-final Office Action, or a request to reinstate the appeal. Applicant exercises the first option, presenting this Amendment, a Declaration Under 37 CFR 1.132, and an IDS citing references that are discussed in the Declaration. The current IDS references are all patents or published patent applications in which Applicant is the sole or a joint inventor, or publications in which Applicant is a joint author.

Discussion of Rejections:

1: Claims 17-19 Rejected as Anticipated by Lazarus

Claims 17-19 are rejected as anticipated by Lazarus, U.S. Patent 4,128,173. For the Lazarus patent to anticipate the claims, every element recited in these claims must be present in the Lazarus patent.

The Examiner does not take proper account of a point made in the Appeal Brief filed January 12, 2004, namely that the "Lazarus apparatus does not have 'vertebroplasty injection components', recited in claim 17, lines 3 and 5, in either tray." In construing terms in claims, the words used should be given their ordinary meaning to persons of ordinary skill in the art.

Neither the Examiner nor the undersigned attorney is a person of ordinary skill in the art to which this invention pertains. The inventor, however, Dr. Kieran Murphy, is a person of more than ordinary skill in the art. Presented herewith is a Declaration Under 37 CFR 1.132,

explaining that the Lazarus apparatus does not have “vertebroplasty injection components”, recited in claim 17, lines 3 and 5, in either tray, as that term is understood by persons of ordinary skill in the art. (See Declaration at pages 3-5, paragraphs 7-12.) Accordingly, the rejection of Claims 17-19 should be withdrawn.

All the more, Lazarus does not anticipate or render obvious the above new Claims 22 and 23.

2: Claims 1-16, 20 and 21 Rejected as Obvious from Vagley

Claims 1-16, 20 and 21 are rejected as obvious in view of the newly-applied patent to Vagley, U.S. 6,158,437, previously cited in Paper No. 9.

With respect to Claims 1-16, 20 and 21, the Examiner has not addressed Applicant’s argument in the Appeal Brief that “the Examiner has used Appellant’s claims as a shopping list to find a patent that teaches each *element* in the combination, but has not cited or applied a reference that teaches the *combination* itself.” The Examiner has withdrawn the Folkman design patent reference, which discloses a tray but does not say what goes on the tray, and substituted the Vagley patent, which discloses a tray and says things *other than* vertebroplasty injection components should be on the tray. In this respect Vagley is a worse reference than Folkman, because it teaches away from Applicant’s invention, instead of just not teaching or suggesting it.

In addition, the enclosed Declaration Under 37 CFR 1.132 explains that the *combinations* claimed in Claims 1-16, 20 and 21 would not have been obvious to a person of ordinary skill in the art, either from Vagley alone or from Vagley in view of the eleven secondary references applied in the Examiner’s third rejection. (See Declaration at page 5, paragraphs 13-14.)

Accordingly, the rejection of Claims 1-16, 20 and 21 should be withdrawn.

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**3: Claims 1-16, 20 and 21 Rejected as Obvious
from Vagley in view of eleven other references**

Claims 1-16, 20 and 21 are rejected as obvious in view of the newly-applied patent to Vagley, U.S. 6,158,437, previously cited in Paper No. 9, further in view of the same eleven secondary references (Shanley, MacLeod et al., Smith et al., Arlers, Racz, Jiang et al., Singer, Draenert, Haynie, Hertzmann et al. and Baker) applied in the Final Rejection which was appealed. None of Vagley or the secondary references teaches or suggests the *combinations* claimed in Claims 1-16, 20 and 21.

Accordingly, the rejection of Claims 1-16, 20 and 21 should be withdrawn.

Conclusion

Reconsideration, withdrawal of the rejections, and allowance of all claims now presented, namely Claims 1-23, are courteously requested.

Claims 17-19, 22 and 23 recite “vertebroplasty injection components”, which are not present in the Lazarus patent. Rather than relying on the Examiner’s opinion or the undersigned attorney’s opinion in this respect, there is presented herewith the Declaration Under 37 CFR 1.132 of the inventor, Dr. Kieran Murphy, showing that the Lazarus patent does not teach “vertebroplasty injection components” as that term is understood by persons of ordinary skill in the art.

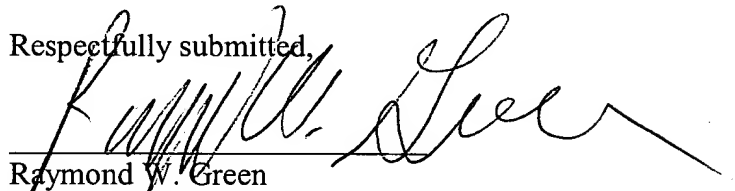
Claims 1-16, 20 and 21 recite combinations, which neither the newly-applied Vagley patent nor any of the secondary references teach or suggest.

Additional comments concerning the patentability of Applicant’s claims are contained in Applicant’s Appeal Brief, to which the Examiner’s attention is directed.

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Accordingly, the Application appears to be in order for allowance, both as to form and in view of the prior art. Such action is courteously requested. The Examiner is urged to allow the Application, rather than going through the formality of an appeal, so that the Board can tell the Examiner that with respect to Claims 17-19, Lazarus does not have "vertebroplasty injection components" and does not anticipate the claims; and that with respect to Claims 1-16, 20 and 21, the Examiner has not cited or applied a reference that teaches the *combination* itself.

Respectfully submitted,



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